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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,946	10/16/2000	David Gillespie		3993

7590 06/17/2004
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Five Hirsch Avenue
PO Box 966
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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/646,946

Applicant(s)

GILLESPIE ET AL.

Examiner

Cheryl Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) 1-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-34 are presented for examination.

INFORMATION DISCLOSURE STATEMENT

2. The information disclosure statements filed on October 26, 2000, paper no. 6 and November 16, 2000, paper no. 7, complies with the provisions of MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

Drawings

3. The applicants' drawings filed on October 16, 2000 have not been approved by the draftsman. Refer to attached form PTO-948.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1, the following limitation is vague: "A document management extension system for Microsoft Exchange wherein the system merges the functionality of index databases, file repositories and messaging systems using Exchange and leverages the tight integration of Exchange and an NT Server for security and redundancy management." [note claim 1]

The format of the claim is improper. The claim has no clear separation between the preamble and the body of the claim. It is difficult to determine distinct boundaries between precise claim limitations in the claim. Specifically the following limitation is unclear: "Microsoft Exchange wherein the system merges the functionality of index databases, file repositories and messaging systems using Exchange and leverages the tight integration of Exchange and an NT Server for security and redundancy management.". See *Festo Corp. V. Shoketsu Kinzoku Kogyo Kabushiki Co.*, F. 3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000). Appropriate correction is required. Claims 2-34 are rejected based on dependency.

CLAIMS

6. Claim 1 contains the trademark/trade name(s) Microsoft Exchange™, NT Server™, etc. (likewise claims 3, 4, 12, 28, 30, and 31 contain trademark/trade name(s)). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name

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cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe card games as shown on page 12 and, accordingly, the identification/description is indefinite.

Specification

7. The specification is objected to because of the following:

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.

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- (1) Field of the Invention.
- (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

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- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

8. The use of the trademarks has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. MPEP 6.20

The following trademarks are:

1. MicrosoftTM Nt Server, page 4, line 3;
2. ExchangeTM and OfficeTM, page 4, line 9.

Likewise, the other trademarks specified throughout the applicants' specification should include the above mentioned trademark corrections.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter et al. (Pat. No. 5,845,067 filed September 9, 1996, hereinafter Porter); Nishiyama et al. (Pat. No. 5,568,640 filed September 30, 1994, hereinafter Nishiyama); and Tada et al. (Pat. No. 5,887,171 filed January 28, 1997, hereinafter Tada).

11. Regarding Claims 1, 7, 11, 12, 16, 21, Porter teaches a method and apparatus for document management utilizing a messaging system.

The method and associated system for document management utilizing a messaging system as taught or suggested by Porter includes:

Microsoft Exchange (col. 6, lines 29-35), file repositories (figure 1 elements 100 and 110, figure 5 element 560, figure 11A elements 1110 and 1115, col. 1, lines 25-32, col. 5, lines 19-21, col. 12, lines 9-49) and messaging systems (Abstract, line 2, figure 2, element 240, col. 3, lines 35-46) using Exchange (col. 3, lines 35-46, col. 6, lines 10-16) and an NT Server (col. 2, lines 45 and 46, col. 3, lines 14-20, col. 6, lines 10-12) for

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security (figure 1, elements 130, 170, and 180, figure 5, element 525, col. 1, lines 44-67, col. 2, lines 1-11) and redundancy management (col. 1, lines 46-56, col. 3, lines 35-57).

However, Porter does not expressly teach a system merging the functionality of indexes of databases.

Nishiyama teaches a system merging (Abstract, lines 6-11 and 16-18, col. 6, lines 49-50, figure 5 'Document Collection Merge', col. 7, lines 5-10 and 15-25) the functionality of indexes of database (col. 4, lines 36-47, col. 5, lines 10-35 and 47-65). Nishiyama teaches a data base, 112, comprises document information storage, 113, which stores documents and an information node storage, 114, which stores information nodes. The indexing functionality of Nishiyama's database requires the classification of documents. Documents are classified according to a document class and the document class is associated with an information node. Also, an information node is further indexed/classified according to data ID, a creator's name, and date of node creation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the document management and accessing document content as taught by Porter with Nishiyama's document retrieval and document management system because Nishiyama's document management and retrieval system enables the classification of documents to be managed with a plurality of node trees constructed in a hierarchical structure, the nodes include three retrieval views having a company with a document related to the company, a product having a document related to the product, and a document class having a document's

specification and a document's minutes (see, Nishiyama, Abstract, lines 1-6, col. 4, lines 43-64).

However, Nishiyama does not expressly teach a document management extension system (Abstract, lines 1-10) and tight integration.

Tada teaches a document management extension system (Abstract, lines 1-3, and tight integration (col. 4, lines 62-67, col. 8, lines 9-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Nishiyama with the method of Tada because Tada's method provides a document management system of high extendability, flexibility, and stability capable of solving problem that as an agent-orient paradigm system extends, the number of agents increases an indefinite factors increase, having a unit for changing an agent into an object is provided for using the agent execution environment as the object execution environment (see Tada, Abstract, lines 1-14).

12. Regarding Claims 2, 15, 19, 20, Porter teaches the user interface means (figure 11, col. 4, lines 55-65).

13. Regarding Claims 3 and 22-34, the limitations of these claims have been noted in the rejection above. They are therefore rejected as set forth above.

14. Regarding Claims 4, 10, 13, 14, Porter teaches the document management extension object store (figure 4, elements 404, 406, 407); status property means (col. 8, lines 1-67, col. 9, lines 1-67, col. 10, lines 1-67); and directory means (col. 8, lines 1-67, col. 9, lines 1-67, col. 10, lines 1-67).

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15. Regarding Claims 5, 9, 17, 18, Porter teaches a document is closed (col. 8, lines 1-67, col. 9, lines 1-67, col. 10, lines 1-67).

16. Regarding Claim 8, Porter teaches the check out command available in any dialog (col. 8, lines 1-67, col. 9, lines 1-67, col. 10, lines 1-67).

CONCLUSION

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

A. Freeman et al. (U.S. Pat. No. 6,006,227) discloses a document stream operating system;

B. Scott et al. (U.S. Pat. No. 5,638,505) discloses a system and method of processing documents with document proxy; and

C. Yoda et al. (U.S. Pat. No. 6,119,117) discloses document management method, document retrieval method, and document retrieval apparatus.

NAME OF CONTACT

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (703) 305-8750. The examiner can normally be reached on 6:30-3:00.

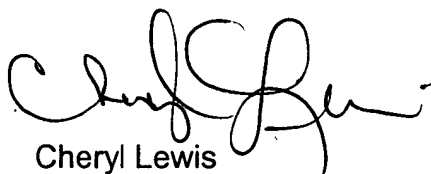
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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(703) 746-5651 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Cheryl Lewis', with a stylized, cursive script.

Cheryl Lewis
Patent Examiner
June 14, 2004